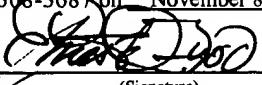




AMENDMENT TRANSMITTAL LETTER				ATTORNEY'S DOCKET NO.: 0015-10		
SERIAL NUMBER: 723,402	FILING DATE: November 28, 2000	EXAMINER: Narayanswamy Subramanian		GROUP ART UNIT: 3624		
INVENTION:						
METHOD FOR DEVELOPING ANSWER-OPTIONS TO ISSUE-QUESTIONS RELATING TO PERSONAL FINANCE AND INVESTMENT						
INVENTOR(s): Tina M. Nocera et al.						
TO THE ASSISTANT COMMISSIONER FOR PATENTS: Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.						
CLAIMS AS AMENDED						
(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) NO. OF EXTRA CLAIMS PRESENT	(6) RATE	(7) ADDITIONAL FEE
TOTAL CLAIMS	34	MINUS	34	0	X \$9	0.00
INDEP. CLAIMS	8	MINUS	8	0	X \$44	0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0.00
<p>* If the entry in column 2 is less than the entry in column 4, write "0" in column 5. ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space. *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.</p>						
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<p><input checked="" type="checkbox"/> No additional fee is required.</p> <p><input type="checkbox"/> Charge \$ _____ to Deposit Account No. _____ copy of this sheet is enclosed.</p> <p><input type="checkbox"/> The undersigned petitions for any extension of time for filing this document required under 37 C.F.R. 1.136 and requests that the \$ _____ fee be charged to Deposit Account No. _____ A triplicate copy of this sheet is enclosed.</p> <p><input type="checkbox"/> Charge any additional fees to Deposit Account No. 01-1125</p>						
November 8, 2004				 Signature Ernest D. Buff Attorney Name		
(908) 901-0220				25,833 Reg. Number		
<p>I hereby certify that this correspondence is being facsimile transmitted to the United States Patent And Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 via Fax. No. (703) 308-3687 on November 8, 2004.</p> <p> (Signature)</p> <p>Ernest D. Buff Attorney of Record</p> <p>November 8, 2004 (Date)</p>						

U.S. PATENT AND TRADEMARK OFFICE

In re Application of: Tina M. Nocera, et al.
Serial No.: 09/723,402
Filed: November 28, 2000
For:

Group Art Unit: 3624
Examiner: Narayanswamy Subramanian

Docket No.: 0015-10

**METHOD FOR DEVELOPING ANSWER-OPTIONS TO ISSUE-
QUESTIONS RELATING TO PERSONAL FINANCE AND
INVESTMENT**

Bedminster, N.J. 07921
November 8, 2004

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOV 18 2004

GROUP 3600

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action dated October 19, 2004, the following remarks are filed.

The Examiner has required restriction under 35 U.S.C. § 121 between the following inventions:

Group I. Claims 1-18, 21, 22, 24-26 and 30-31, drawn to methods of providing to a user a plurality of answer-options to an issue-question relating to personal finance and investment, the methods including the steps of identifying and storing in the memory storage device a plurality of topics relating to personal investment and finance; developing and storing in the memory storage device a plurality of issue-questions directed to each of the stored topics; and developing and storing in the memory storage device an expert opinion for each issue-question, classified in class 705, subclass 36;

Group II. Claims 19-20, drawn to a method of providing to a user a plurality of answer-options comprised of an expert opinion and a prudent-investor opinion, the method including the steps of constructing an input mask by entering, by the user via the input device, a variable criterion; identifying a plurality of issue-questions that satisfy the variable criterion using the input mask; and identifying a plurality of answer-options to the identified issue-questions, classified in class 705, subclass 36;

Group III. Claim 23, drawn to a method of providing to a user a plurality of answer-options comprised of an expert opinion and a prudent-investor opinion on an issue-question, the method

including the steps of submitting an issue-question in free-form, by the user via the input device; and editing the issue-question for proper grammar and form, classified in class 705, subclass 36; and

Group IV. Claims 27-29 and 32-34, drawn to methods of providing to a user a plurality of answer-options comprised of an expert opinion and a prudent-investor opinion on an issue-question, the methods including the step of attempting to match at least one stored issue-question with the submitted question, using in combination Bayesian inference and information theory, classified in class 705, subclass 36.

In response to the restriction requirement, applicants elect, with traverse, the invention of Group I, claims 1-18, 21, 22, 24-26 and 30-31 for further prosecution on the merits.

Reconsideration of this restriction requirement is respectfully requested. The Examiner has stated that the inventions of Group I and Group II, respectively, are separate and distinct because they are shown to be separately usable. The Examiner, citing MPEP § 806.05(d), has stated that clearly the step present in one method is not present in the other, making the two methods distinct and different. However, MPEP § 806.05(d) clearly states that “[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. ... The burden is on the examiner to provide an example.” Applicant respectfully submits that the Examiner has not satisfied this burden. Simply stating that the step present in one method is not present in the other makes the two methods distinct and different is a conclusory statement without merit. Furthermore, “the step” to which the Examiner is referring has not been specifically referenced in the Office Action, rendering further analysis thereof impossible. Nevertheless, it is submitted that the Examiner’s arguments are general in nature, and include no specific example in support of the conclusion that one of the subcombinations has utility other than in the disclosed combination. Therefore, it is submitted that the inventions of Group I and Group II, respectively, have not been shown to be separate and distinct. In addition, it is submitted that the Examiner’s recitation of the claim language of Group I and Group II, respectively, has omitted several elements of the broadest independent claim of each respective Group. See Applicant’s Amendment document (Paper #10) filed in connection with a Request For Continued Examination (RCE) (Paper #11) on October 27, 2003.

The Examiner has stated that the inventions of Group I and Group III, respectively, are separate and distinct because they are shown to be separately usable. The Examiner, citing MPEP § 806.05(d), has stated that clearly the step present in one method is not present in the other, making the two methods distinct and different. However, as noted previously hereinabove, MPEP § 806.05(d) clearly states that “[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. ... The burden is on the examiner to provide an example.” Applicant respectfully submits that the Examiner has not satisfied this burden. Simply stating that the step present in one method is not present in the other makes the two methods distinct and different is a conclusory statement without merit. Furthermore, “the step” to which the Examiner is referring has not been specifically referenced in the Office Action, rendering further analysis thereof impossible. Nevertheless, it is submitted that the Examiner’s arguments are general in nature, and include no specific example in support of the conclusion that one of the subcombinations has utility other than in the disclosed combination. Therefore, it is submitted that the inventions of Group I and Group III, respectively, have not been shown to be separate and distinct. In addition, it is submitted that the Examiner’s recitation of the claim language of Group I and Group III, respectively, has omitted several elements of the broadest independent claim of each respective Group. See Applicant’s Amendment document (Paper #10) filed in connection with a Request For Continued Examination (RCE) (Paper #11) on October 27, 2003.

The Examiner has stated that the inventions of Group I and Group IV, respectively, are separate and distinct because they are shown to be separately usable. The Examiner, citing MPEP § 806.05(d), has stated that clearly the step present in one method is not present in the other making the two methods distinct and different. However, as previously noted, MPEP § 806.05(d) clearly states that “[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. ... The burden is on the examiner to provide an example.” Applicant respectfully submits that the Examiner has not satisfied this burden. Simply stating that the step present in one method is not present in the other makes the two methods distinct and different is a conclusory statement without merit. Furthermore, “the step” to which the Examiner is referring has not been specifically referenced in the Office Action, rendering further

analysis thereof impossible. Nevertheless, it is submitted that the Examiner's arguments are general in nature, and include no specific example in support of the conclusion that one of the subcombinations has utility other than in the disclosed combination. Therefore, it is submitted that the inventions of Group I and Group IV, respectively, have not been shown to be separate and distinct. In addition, it is submitted that the Examiner's recitation of the claim language of Group I and Group IV, respectively, has omitted several elements of the broadest independent claim of each respective Group. See Applicant's Amendment document (Paper #10) filed in connection with a Request For Continued Examination (RCE) (Paper #11) on October 27, 2003.

The Examiner has stated that other pairing of inventions stated above are related as subcombinations disclosed as usable together in a single combination, and that these inventions are distinct from each other as can be evident from the definition of the groups described above. The Examiner also has stated that they require separate searches and hence restriction of these inventions for examination purposes as indicated is proper. Applicant respectfully submits that since the Examiner has provided no specific examples to show that these inventions are distinct from each, withdrawal of the restriction requirement is proper.

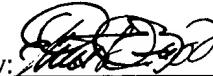
Furthermore, it is submitted that the relationship between Group I, Group II, Group III, and Group IV, respectively, is a close one, there being for each of Groups 1-IV essentially the same procedural concepts in the broad aspect of the invention. For example, each Group relates to a method of providing to a user a plurality of answer-options to an issue-question relating to personal finance and investment, wherein at least one expert opinion and at least one prudent-investor opinion is provided by the method.

It is well established that applicants should be allowed reasonable latitude in claiming their invention, provided they do not unduly multiply the claims, which is not the case here. Ex parte Seiback 151 U.S.P.Q. 62. It is submitted that the fields of search involved in examining the claims as grouped would, as a practical matter, be essentially co-extensive and the best interests of the public would be served by having all of the claimed subject matter in the same application.

Accordingly, reconsideration of the restriction requirement is respectfully requested.

In view of the election taken herein and the remarks set forth above, it is submitted that this application is in allowable condition. Accordingly, withdrawal of the requirement for restriction and allowance of the application is earnestly solicited.

Respectfully submitted,
Tina M. Nocera, et al.

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